

Appl. No. 10/811,160
Atty. Docket No. 9596
Amdt. dated July 10, 2007
Reply to Office Action mailed May 11, 2007
Customer No. 27752

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REMARKS

No amendments to the instant claims are presented by way of the current amendment. Claims 2, 8, 10, 15, 17, and 20 have been withdrawn from consideration. Applicants respectfully request rejoinder of the withdrawn claims pursuant to M.P.E.P. §821.04 upon the indication of allowable subject matter. Claims 1-20 remain pending in the instant Application and are presented for the Examiner's reconsideration in light of the following comments.

Rejection Under 35 U.S.C. §103

Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been rejected under 35 U.S.C. §103(a) over *McCay, et al.*, U.S. Patent No. 4,506,575, in view of *Esping, et al.*, U.S. Patent No. 6,761,098. For the sake of brevity, previous arguments regarding the *McCay* reference remain in effect and will not be repeated. Applicants respectfully traverse this rejection and request the Examiner to consider the following additional matters that distinguish Applicants' invention as now presented over *McCay* in view of *Esping*.

1. Applicants' independent Claims 1, 9, and 16 require the apparatus for slabbing a roll to comprise, *inter alia*, a transport element capable of engaging and conveying the roll to a slabbing position. The transport element further comprises a pair of roll engaging elements capable of penetrating engagement of the core. It is in this way that the roll may be transported from a roll engaging position to a slabbing position within the same apparatus.

2. Applicants are at a loss to understand how the side supports 7 and 8, as disclosed in the *Esping* reference can be combined with the core slabber as disclosed in the *McCay* reference. The *McCay* reference requires "the core [to be] slipped on the tube 18 over the tube lock plate 17." (3:40-41) Further, "A tube stem 22 forming a pillar supports the horizontal tube 18 which extends longitudinally, parallel to the path of travel of the carriage 13 and the rails 31, 32." (3:12-14) In other words, a core having paper disposed thereon must be placed onto the tube 18 from one end of the tube. This is because one end of the cantilevered tube is obstructed by the support that suspends the tube 18. The end distal from the tube support is the only location from which a core may be disposed upon the tube in order to utilize the *McCay* core slabber.

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3. Applicants are at a loss to understand how the side supports, as disclosed by the *Esping* reference, which ostensibly engage opposing ends of a core, can be combined with, and much less utilized with, a cantilevered tube as disclosed by the *McCay* reference.

Assuming, *arguendo*, that the side supports 7 and 8 could be used in conjunction with an apparatus as disclosed by *McCay*, one of the side supports (either 7 or 8) would have to be removed from the core in order to effectuate positioning of the core upon the tube. One of skill in the art would likely understand that removal of one of the side supports (either 7 or 8) of the *Esping* reference would cause the core to catastrophically drop from the remaining support (either 7 or 8) onto some supporting surface. It is inconceivable to Applicants, and likely to those of skill in the art, how to appropriate the side supports (7 and 8) of the *Esping* reference and use them in concert with the tube of the *McCay* core slabber. Further, there is no disclosure, teaching, and/or suggestion in either the *McCay* or *Esping* references to combine a pair of side supports such as those disclosed in the *Esping* reference with the tube-based core slabber as disclosed in *McCay*.

"A critical step in analyzing the patentability of claims pursuant to §103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." See *In re Kotzab*, 208 F.3d 1352, 54 U.S.P.Q. 2d 1308 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." See *id* (quoting *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 2d 303, 313 (Fed. Cir. 1983)). Further, "The genius of invention is often a combination of known elements which in hindsight seems pre-ordained. To prevent hindsight invalidation of prior claims, the law requires some 'teaching, suggestion or reason' to combine the cited references." See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001). When the art in question is relatively simple, . . . the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied

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rigorously." *See id.* Finally, "Both the suggestion and the reasonable expectation of success 'must be founded in the prior art, not in the applicant's disclosure.'" *See In re Vaeck*, 947 F.2d 488, 493, U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Because of these considerations, the combination of *McCay* and *Esping* references does not teach, disclose, or suggest Applicants' claimed apparatus for slabbing a roll of material comprising a transport element capable of engaging and conveying the roll to a slabbing position and where the transport element further comprises a pair of roll engaging elements capable of penetrating engagement of the core. The *McCay* and *Esping* references fail to disclose, teach, suggest, or even remotely render obvious, either singly or in combination, every recited feature of Applicants' independent Claims 1, 9, and 16 or all claims dependent directly or indirectly thereon. Applicants therefore respectfully request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to the instant claims.

Conclusion

Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, and no fee is believed due. However, if any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

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